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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,263	03/04/2002	Scott C. Nance	4248P2441	4043

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EXAMINER

AMSBURY, WAYNE P

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,263

Applicant(s)

NANCE, SCOTT C.

Examiner

Wayne Amsbury

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

3-0-C

CLAIMS 1-23 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's arguments filed 4/19/05 have been fully considered but they are not persuasive.

In the response, Applicant states:

*Although cellular or wireless type phone numbers were well known at the time of Smith, Smith does not teach, disclose, or suggest that the device may be used to locate such numbers.*

As noted in the cited passage of the rejection, the system of Smith is operated by dialing phone numbers [COL 2 lines 54-56]. The particular mode of communication for the dialing process is not significant for the teachings of Smith as they were applied to maintaining a phone database, publishing in a phone book and the like [previous action, page 4 second paragraph]. It was Shaffer that was used to support the use of wireless and/or cellular phone connections.

Applicant states:

*Shaffer, like Smith, presupposes the existence of a publicly accessible, searchable database of cellular numbers and users in order to incorporate such data.*

*Shaeffer [sic] in no way teaches how such a database may be compiled from a cellular service provider data and made publicly available, and therefore cannot render Applicant/s claimed invention obvious.*

First, these statements support the contention that Smith has access to *cellular* numbers, however the connection to such a database may be made. Second, the claims, such as claim 1, do not include the limitation *publicly*. Third, the actual claim language also provides no mechanism for compiling the source data, merely accessing a list of (cellular) phone numbers. Fourth, claims, such as claim 1, could be entirely carried out within the organization of a cellular phone provider. Alternately, the list could itself be a (published) public database of cellular phone numbers and satisfy the claims. Fifth, one of ordinary skill at the time of the invention would be well aware that the modifier *cellular* with respect to phone numbers is nonfunctional description; such numbers have exactly the same format as other phone numbers.

Finally, it is noted that a line phone number can be reached from a cellular phone and vice versa, so any source of data reachable by one is reachable by the other.

Applicant states [page 5 of response]:

*Applicant respectfully notes the existence of substantial distinctions between traditional and cellular or wireless type services, ... [Emphasis is added.]*

Yes, but compiling and publishing a phone number database from a list of phone numbers does not require any distinction between cellular and non-cellular phone numbers, nor are any of the steps of the claims directed to such differences, if they exist.

**3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US 6,173,045, 9 January 2001 and Shaffer et al (Shaffer), US 5,901,214, 4 May 1999.**

Smith is directed to an electronic phone book as an improvement and adjunct to the prior art of printed telephone books [COL 1 lines 12-19]. Smith does not explicitly address the type of telephone service, such as the use of cellular or wireless phones, but does provide for access in an embodiment that is directly accessible from a phone [COL 2 lines 20-36]. Alternately, the phone book may be an integral unit of the phone or reside on a CD-Rom drive [COL 2 lines 51-65]. Further, the phone book may communicate with a central repository [COL 2 line 66 to COL 3 line 4]. These embodiments as a whole suggest that any phone access will support the system.

Shaffer is directed to an intelligent call processing system that involves databases and directories [ABSTRACT; COL 2 lines 7-25; COL 3 line 42 to COL 5 line 30]. As one example, Shaffer teaches the use of a reverse directory search [COL 5 lines 5-14], which is clearly a variation of (standard) directory search. As another, Shaffer teaches the use of directory assistance [COL 21 lines 32-35].

Shaffer is not explicit in his treatment of alphabetical indexing, phone books, CD-Rom publishing, and the like, but does make it clear that his system applies to cellular phones [COL 7 lines 43-46]. The system of Shaffer uses Local Exchange Routing Guide (LERG) files and their derivatives [COL 21 line 60 to COL 22 line 4 and elsewhere throughout].

Shaffer teaches that one source of telephone number changes is Bellcore and that this information is published and publicly available [COL 21 lines 51-59]. Of particular interest here is the teaching of Shaffer that cellular numbers are simply distinguished by a telephone code type and thus the cellular aspect of directory use of the number is moot [COL 43 lines 22-44]. This suggests that directory assistance, such as that provided by a phone book, is not fundamentally different for phone service of differing types, such as for cellular phone services.

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to apply the teaching of Shaffer that cellular phone use is not fundamentally distinct from other phone use with respect to directory and database service to the system of Smith because to do so would greatly extent the applicability and utility of Smith's telephone book.

As to **claim 1**, lists of telephone numbers are generated by phone service providers, as noted by Shaffer [COL 21 lines 51-59], no other source can provide an essentially complete list, and thus those numbers of cellular type are provided by a cellular phone provider. Telephone books that include cellular phone users correspond to compiling a list of cellular phone users from at least one cellular phone provider, and a list of corresponding cellular phone numbers of said cellular phone users.

Such lists are maintained in a database [Smith COL 3 line 66 to COL 4 line 11]. The database is published variously in a phone book [Smith COL 1 lines 12-14], CD-Rom [Smith COL 2 lines 56-64], or made available through a network [Smith FIG 2; COL 2 lines 45-52].

It is inherent in the definition of a database that users search it, and this is taught explicitly by Smith at COL 1 lines 64-67.

As to **claim 2**, Smith provides for alphabetical lookup [COL 3 lines 41-49].

As to **claim 6**, Smith teaches the use of advertisement in telephone books, and it is inherent in the use of such advertisements that their purpose is to generate revenue.

As to **claim 7**, Smith and Shaffer do not explicitly state that separate directories are created for separate cellular phone providers. However, the information available to a provider is the database of their own subscribers, and the subscribers to other services are not available to a provider until published. Thus at some level of access, it is necessary for separate providers to separately publish lists of subscribers. Further, there are economic motivations within the knowledge of one of ordinary skill in the art for a provider to not publish the list of subscribers to other services.

For instance, supporting access to one's own subscribers with a dedicated phone directory clearly creates a community of access that would tend to promote subscriptions within the community because access is made easier by that directory.

As to **claim 8**, **Official Notice** is taken that at the time of the invention, it was well known to provide phone books services independently of phone providers, both "yellow pages" and "white pages".

The elements of this claim correspond to the creation of such a phone book in a manner that has no requirements specifically dependent on whether or not the phone service is cellular.

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide a multi-provider phone book for cellular services for the same reasons that they are provided for other phone services. It is clearly a commercially viable operation from the history of phone books, and of use to subscribers.

As to **claim 9, Official Notice** is taken that the use of unlisted numbers was well known at the time of the invention, and supported by numerous motivations. The elements of the claim correspond to providing for unlisted numbers.

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for unlisted cellular numbers because subscribers desire them. One motivation is the charges for incoming calls to cellular phones.

As to **claims 11-12**, Shaffer is directed to VOIP (voice operated) directory services [ABSTRACT and elsewhere throughout], as an improvement on person-operated directory and answering services [BACKGROUND and elsewhere throughout].

As to **claims 13-15**, Smith provides for downloading at least in part onto a local device [FIG 3a-3f], and certainly downloading to a CD-Rom corresponds to downloading to a computer. **Official Notice** is taken that downloading data to a cellular phone and/or to a PDA was well known in the art at the time of the invention. The name of data (alphabetical directory in this case) is not a patentable limitation.

The elements of **claims 3-5, 10 and 16-23** are rejected in the analysis above and these claims are rejected on that basis.



**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


**5.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 **FIRST WEEK**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER